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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/723,922	11/24/2003	Thierry Stora	81455-5520	9784

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EXAMINER	
COLE, MONIQUE T	
ART UNIT	**PAPER NUMBER**
1743	

DATE MAILED: 12/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

AS

Office Action Summary	Application No.	Applicant(s)	
	10/723,922	STORA, THIERRY	
	Examiner	Art Unit	
	Monique T. Cole	1743	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *24 September 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-20* is/are pending in the application.

4a) Of the above claim(s) *14-20* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1- 13* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☒ Claim(s) *14-20* are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Allowable Subject Matter

1. The indicated allowability of claims 6-9 & 11 is withdrawn in view of the newly discovered reference(s) to USP 6,419,909. Rejections based on the newly cited reference(s) follow.

Election/Restrictions

1. Newly submitted claims 14-20 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: the new addition of the claim limitation "wherein the oily phase includes therein an oil-soluble agent having a higher density than oil" was not originally claimed and requires further search & consideration.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 12-20 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Information Disclosure Statement

2. The listing of references in the remarks/response to amendment is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609 A(1) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1, 2, 3, 4, 5 and10 rejected under 35 U.S.C. 102(b) as being anticpated by USP 6,403,109 to Stora (Stora).

Stora teaches a transparent perfume composition in the form of an O/W or W/O emulsion, said emulsion containing from 5-50% by weight of dispersed phase and 50-95% of continuous phase. The viscosity of the composition is less than 10 Pa. s. See claims. The density of the Stora composition is inherently the same as that instantly claimed since the components are the same and used in the same amounts.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claims 6-9 and 11-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stora as applied to claims 15-& 10 above, and further in view of USP 6,419,909 to Lorant et al. (herein referred to as "Lorant").

Stora differs from the instant claims in that it does not disclose the addition of volatile fluorinated oil in the transparent perfuming emulsion.

Lorant teaches that it is beneficial to employ volatile fluoro-compounds such as nonafluromethoxybutane to such compositions because it makes it possible to obtain emulsions that have good transparency, give cosmetic properties of feeling pleasant and comfortable as well as an immediate freshness effect from the moment applied. See col. 1, lines 62-67; col. 2, lines 1-5; col. 3, lines 25-29 and 46-49; col. 4, lines 58-63. Thus, it would have been obvious to one having ordinary skill in the art to modify the transparent perfuming emulsion of Stora by adding Lorant in order to obtain a more beneficial cosmetic/perfuming product.

With regard to the process of making the claimed composition, it is the Examiner's position that this process is disclosed by the combination of Stora & Lorant. The claimed composition solely consists of adding the fluorinated oil in a specified amount.

Double Patenting

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 1, 3, 4, 5 & 10 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 2, 14, 17 & 19 of U.S. Patent No. 6,403, 109 (herein referred to as "the '109 patent"). Although the conflicting claims are not identical, they are not patentably distinct from each other because the scope of the '109 patent claims are embraced by the instant claims.

7. Claims 1, 3, 5 & 10 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 2, 4, 5 & 14 of U.S. Patent No. 6,774,101 (herein referred to as "the '101 patent"). Although the conflicting claims are not identical, they are not patentably distinct from each other because the scope of the '101 patent claims are embraced by the instant claims.

Response to Arguments

8. Applicant's arguments filed 9/24/2004 have been fully considered but they are not persuasive. Applicant's primary argument is that the Stora reference does not inherently teach the density as claimed in claim 1. Applicant supports this position by stating that the Stora emulsions, which are focused on the values of the refractive index, n, do not contain any ingredient that can suitably increase the density of oil to bring it closer to the density of water. Applicant further states that the density difference between oil and water is advantageously decreased in the present invention by adding a certain agent, such as volatile fluorinated oil, to the oily phase of the perfuming composition.

However, in response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e.,

addition of oil soluble agent) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Instant claim 1 does not recite the additional component, and is therefore no different than the Stora disclosure. Thus, as mentioned above, it is reasonable to expect that the Stora composition would inherently possess the same density since the components are the same as the instant claims and are used in the same amounts. By Applicant's own admission (see remarks, page 5 bridging to page 6, line 4), it is by the addition of the certain agent that the benefit of improving physical stability is achieved by bring the density values of the oily phase and aqueous phase closer to each other.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Monique T. Cole whose telephone number is 571-272-1255. The examiner can normally be reached on Monday-Thursday from 6:30 A.M. to 4:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on 571-272-1267. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

M. T. Cole

Monique T. Cole
Examiner
Art Unit 1743

mtc